



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,231	10/29/2003	Merlin Stover	P06457US00	5252

22885 7590 06/03/2005

MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

KOYAMA, KUMIKO C

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,231

Applicant(s)

STOVER, MERLIN

Examiner

Kumiko C. Koyama

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement is made of receipt of Amendment filed on April 20, 2005.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5,838,814) in view of Pearson (US 6,764,015).

Moore teaches a check 5, which is a negotiable instrument, having a picture 6, which is digitally derived (col 6, lines 51-55), and an authorized signature template 12 (col 7, lines 12-14) as shown in Fig. 1. Moore also teaches that check 5 may include an invisible, machine-readable, authorized signature template or coded representation of unique parameters thereof, such representation which may take the form of an invisibly imprinted bar code 17 or an embedded polymeric string with bar coded information incorporated therein 18 (col 7, lines 12-18). Moore also teaches an electronic reading means at central clearing house preferably provides for a use of a scanner capable of reading both visible data and the data printed with invisible or substantially invisible print (col 8, lines 8-11). Such disclosure teaches reading the barcode on the negotiable instrument. Moore teaches that there is provided a means 9 for identifying to a transacting financial institution whether actual identification of the maker was made at the time

Art Unit: 2876

of transaction (col 6, lines 58+), which shows comparing the photo identification upon the negotiable instrument to the writer. Moore further discloses that the process employed for verification of authenticity at central clearing house involves comparison of the characteristics of the visible and invisible marks with each other and with information relating to valid marks stored in data processing means 27 (col 8, lines 19-25). Such disclosure teaches comparing the bar code and the pre-printed signature upon the negotiable instrument to the signature placed by the writer upon the negotiable instrument.

Moore fails to teach that the method is used for identity theft protection. Moore also fails to teach that the code drives personal identification information that would create an identity theft concern.

Pearson teaches a check having an MICR line consisting of the account number, routing number and typically check number (col 1, lines 40-42). A check according to the invention has an MICR line which is blocked from visual theft by merging a black bar of non-magnetic ink or other impediment with the MICR line. Sensitive account information is blocked from potential theft preventing many different forms of identity and account fraud (col 1, lines 42-50).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Pearson to the teachings of Moore in order to protect personal or account information from being viewed to prevent identity theft and account fraud.

3. Claims 2-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Pearson as applied to claim 1 and 6 above, and further in view of Iguchi et al

Art Unit: 2876

(US Patent Application No. 2002/0071682). The teachings of Moore as modified by Pearson have been discussed above.

Wilkinson as modified by Martin fails to teach that the personal information from the bar code comprises a home address and telephone number.

Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Wilkinson as modified by Martin in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Pearson and Iguchi as applied to claim 8 above, and further in view of Wilkinson (US 5,863,074). The teachings of Moore as modified by Pearson and Iguchi have been discussed above.

Re claim 9: Moore as modified by Pearson and Iguchi fail to teach that the personal information in the pre-printed bar code further comprises a digital photograph of the writer.

Wilkinson discloses that the picture input is received through preloaded memory such as a disk or from a photograph whose image is input through a scanner connected to the personal computer (col 5, lines 19-23). Such disclosure teaches that the photograph is in a digital format.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Wilkinson to the teachings of Moore as

Art Unit: 2876

modified by Pearson and Iguchi in order to provide as many information possible into the barcode such that it is not visible as well as adding more information that can uniquely identify the writer to prevent fraud and identity theft.

Re claim 10: Moore further teaches that the bar code includes a digital image of the writer's signature as provided above in claim 6.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Pearson as applied to claim 6 above, and further in view of Bi et al (US Patent Application 2003/0173406). The teachings of Moore as modified by Pearson have been discussed above.

Moore as modified by Pearson fail to teach that the bar code is placed adjacent the visible photo of the writer.

Bi teaches that the barcode is placed adjacent the visible photo of the writer (Fig. 1).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bi to the teachings of Moore as modified by Pearson such that the person accepting the check can easily and quickly locate the barcode and identify the existence of barcode to ensure that the writer's information is retrievable.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Iguchi (US Patent Application No. 2002/0071682).

Pearson shows a bank check 1 without any personal information, such as home address and telephone number, visible as shown in Fig. 1 and Fig. 2. Pearson also shows a black bar 3, which includes indicia that identifies account number, routing number and check number (col 1, lines 44+). A check according to the invention has an MCIR line which is blocked from visual theft by merging a black bar 3 of non-magnetic ink or other impediment with the MICR line.

Art Unit: 2876

Sensitive account information is blocked from potential theft preventing many different forms of identity and account fraud (col 1, lines 42-50).

However, Pearson fails to teach a pre-printed bar code having a home address and telephone number.

Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Pearson in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Iguchi as applied to claim 12 above, and further in view of Houvener. The teachings of Pearson as modified by Iguchi have been discussed above.

Pearson as modified by Iguchi fails to teach that the pre-printed bar code further comprises a digital photograph of the writer and a digital image of the writer's signature.

Houvener teaches that a database retrieval system where the database includes digital photographic image, signature or other unique data to individuals for positive identity verification purposes and a bar code system for retrieving the database information (col 4, lines 18-21 and col 5, lines 15-20).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Houvener to the teachings of Pearson as modified by Iguchi in order to enhance fraud protection by storing more specific information

Art Unit: 2876

regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Iguchi as applied to claim 12 above, and further in view Perttunen et al (US 5,939,699). The teachings of Pearson as modified by Iguchi have been discussed above.

Pearson as modified by Iguchi fail to teach the pre-printed bar code comprises a social security number of the writer.

Perttunen teaches a prestored code that includes a social security number (col 4, lines 30-36). The prestored code is a bar code (col 4, lines 37-38).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Perttunen to the teachings of Pearson as modified by Iguchi because social security number is a combination of numbers uniquely assigned to one person that is commonly used to link the person and his/her financial information. Such modification enhances the security of the check by uniquely identifying the person cashing the check.

Response to Arguments

9. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has amended claims 1, 6 and 12 with new limitation, such as "identity theft." Such new limitation necessitated new search and consideration. Therefore, Applicant's arguments are moot in view of new grounds of rejection.

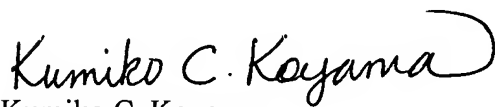
Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394.

The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kumiko C. Koyama
May 31, 2005


DIANE I. LEE
PRIMARY EXAMINER